Paper No. 76

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROY D. SEEL

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Appeal No. 1997-2021
Application No. 08/500,231

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ON BRIEF

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Before THOMAS, HAIRSTON and KRASS, Administrative Patent Judges

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a paper filed September 20, 2000, appellant requests that we reconsider or rehear our decision dated March 22, 2000, where- in we sustained the rejection of claims 21 through 24, 26 through 28, 30 and 31 under the public use clause of 35 U.S.C. § 102(b). The application file reveals that subsequent to our earlier decision in March, appellant

was granted various extensions of time to file this request for rehearing.

Pages 2 and 3 of our original opinion set forth a brief file history of prosecution of this application as well as its earlier applications.

This is the fourth appeal in this application before the Board. As indicated at page 3 of our original decision, after the third decision on appeal, appellant sought relief at Federal District Court in the District of Columbia. The present application was filed at the direction of the presiding judge in that appeal with instructions that declarations of all those who saw the video booth more than one year before the great grandparent application Serial No. 07/170,924, filed on March 21, 1988, should be filed in the present application. Therefore, the critical date in question is March 22, 1987.

At the outset, to the extent appellant's request for rehearing urges a reconsideration of the decision rendered in each of the first three appeals, as set forth more or less in the first twenty six paragraphs of the request for rehearing,

the request is denied. Appellant has long lost any rights accorded to him under the rules of practice to seek any relief for any

alleged errors in these earlier decisions on appeal. Of those first three appeals taken by appellant during earlier prosecution of parent applications of this application, a request for reconsid-eration was filed in a timely manner only with respect to the second appeal in Appeal No. 92-1594 which request was denied on June 18, 1992. We are unaware of any provision of 37 CFR § 1.197 which permits appellant to seek a reconsideration of prior appeals after the time set therefor has expired.

We have considered appellant's positions set forth between paragraphs 27 and 44 of the request for rehearing. It is believed that the discussion at pages 4 and 5 of our original opinion in effect basically still answers the urgings for reconsideration set forth in the above noted paragraphs. For emphasis, we repeat again the essence of the statement we

made at page 4 of our original opinion that the focus of the affirmance of the rejection was, as urged by the examiner, the absence of any curative and subsequent declarations from declarants McLaughlin, Goman, Floam [sic: Flom] specifying the year in which they each saw the video booth located in the so-called Commercial

Craft facility. We did not accept in our original opinion nor do we accept now, without confirming declarations, appellant's own declarations or those of others averring or otherwise declaring that declarants McLaughlin, Goman and Flom agreed to the confidentially and limited control of the video booth in this Commercial Craft facility before the critical date. We do not question that appellant's own direct declaration and those of other individuals may be probative of a pattern of behavior of individuals agreeing to the confidentiality and limited control of access of the video booth at the time it was seen by the respective individuals.

We made specific findings at the top of page 5 of our

original opinion regarding the declarations of Mr. Flom and Goman. Mr. Flom's declaration of August 2, 1989, indicates that he saw the prototype booth operating satisfactory during the month of September 1987, but this declaration contains no statement of confidentiality and no statement as to where the booth was located when it was seen by the declarant. The subsequently filed declaration filed in August of 1995 from Mr. Flom, although it includes a statement of confidentiality, does

not indicate in what year he observed the booth in operation at the Commercial Craft facility. Because this is a subsequently filed declaration, we do not have the certainty we require that the booth was seen to be operated after the critical date of March 22, 1987. The observations by Mr. Flom past the critical date are not probative of the issue before us.

A similar conclusion can be reached with the declarations from Mr. Goman. His July 31, 1987, declaration indicates that he saw the prototype video booth operating satisfactory during

the month of April 1987, while, on the other hand, the subsequently filed declaration on July 31, 1995 does not include the year in which Mr. Goman saw the operation of the booth at the Commercial Craft facility even though the declaration of this date indicates an agreement as to confidentiality. The initial declaration contains no statement as to where the booth was located when it was seen by the declarant. Again, any events that occurred after the critical date are not probative of the issue before us as it applies to Mr. Goman.

As to the third individual in question, Mr. McLaughlin, his initial declaration of July 31, 1989 indicates that he saw the

prototype video booth operating satisfactory during the month of March 1987. While not indicating any sense of any agreement as to confidentiality in this declaration, it cannot be determined
from this declaration that he saw the operation of the prototype

video booth before or after the critical date of March 22, 1987. There is also no statement as to where the booth was located when it was seen by the declarant. His subsequently filed declaration filed on July 31, 1995, does not cure these defects even though it does indicate that a sense of confidentiality was agreed to while at the same time no year was specified as to when he observed the prototype booth in the Commercial Craft facility. Again, since this was a subsequently filed declaration, we remain unpersuaded that he agreed to any sense of confidentiality before the critical date.

In essence, we remain unconvinced that all of the people who observed the prototype video booth in operation before the critical date agreed to the confidentiality and limited control thereof at the Commercial Craft facility as required at the direction of the presiding judge in the Federal District Court discussed earlier in this opinion and noted at the top of page 3 of our earlier opinion. Even if we consider collectively both

declarations from each of the three declarants, McLaughlin,

Flom and Goman, it has not been convincingly established to us by their own declarations that each of them respectively agreed to the confidentiality concerning any demonstrations of the prototype claimed invention before the critical date. It is not sufficient for appellant and/or other people to make declarations that other people were made subject to confidentiality and the complete control of the facility was maintained prior to the critical date without confirming declarations or affidavits from the respectively named individuals. As set forth at the bottom of page 4 of our original opinion, we can conclude only that not all of the people who saw the video booth at the Commercial Craft facility were made subject to secrecy agreements and that complete control of that facility was not maintained prior to the critical date. The public policy considerations underlying the prior public use provisions of 35 U.S.C. § 102(b) demand no less.

Finally, we considered at page 5 of our original opinion, the particulars regarding the alleged special consideration aspects of appellant's arguments relating to independent claim 31 and its dependent claims. This claim focuses on the two-

way

mirror feature of the claimed invention. We required proper, additional declarations from the three earlier noted individuals subsequent to our earlier decision on appeal to obviate any sub-
issue with respect to the special considerations as well as the assertion of private experimental use also discussed at the bottom of page 6 of our last decision in Appeal No. 94-1463 to which we made specific reference and incorporated by reference into our original opinion in March of this year (2000). Paragraphs 46 and 47 of appellant's request for rehearing merely indicate that appellant's attempts to seek the subsequent declarations "were unsuccessful". In paragraph 47 of the request for rehearing appellant urges the allowance of claim 31 and its dependent claims "because these indiviguals [sic] said it was too long ago to specifically recall details about their involvement with the booth." On their face, appellant's urgings do not convince us of any error in our original opinion as to any subissue relating to

claim 31 and its respective dependent claims.

In view of the foregoing, appellant's request for rehearing is granted to the extent that we have in fact reviewed our findings but is denied as to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
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